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Michael K. Au

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BOCA RATON, FL 33487

EXAMINER

DUNHAM, JASON B

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL K. AU,
CONAN MING Y. CHAN,
SAU CHU CHAN,
LEV MIRLAS, and
ALEX SHUM

Appeal 2009-012763
Application 10/751,742
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Michael K. Au (Appellants) filed a Request for Rehearing of the Decision. The Board had affirmed the Examiner's decision rejecting claims 1, 4-7, 10-13, and 16-20 and reversed the Examiner's decision to reject claims 2, 3, 8, 9, 14, and 15.

In accordance with 37 C.F.R. § 41.52(a)(1), the Request includes certain points, in particular, that the Appellants believe the Board misapprehended or overlooked in reaching its Decision. The Appellants argue that the Board misapprehended or overlooked certain arguments because the "the Honorable Board appears to have refused to consider Appellants' argument on the basis that these arguments were not properly framed." Request 4. The Appellants' argument centers on the Boards' finding that an argument made by the Appellant is not based on limitations appearing in the claim (Decision 9). The Decision states:

Turning to the Appellants' second argument, the Appellants argue that Haynes does not describe that "a user is able to access a supplier catalog, which is separate from the aggregated catalog." App. Br. 15. However, claim 1 does not require that the supplier catalog is separate from the aggregated catalog as the Appellants seem to argue (*Id.*) Claim 1 states "providing a buyer with access to said aggregated catalog and *separate access* to at least one of said plurality of supplier catalogs on said commerce site." (Emphasis added.) It is the "access" that is separate and not the catalogs.

² Our decision will make reference to the Appellants' Request for Rehearing (filed Oct. 12, 2010, "Request"), the BPAI Decision (mailed Aug. 12, 2010, "Decision), the Appellants' Appeal Brief (filed Feb. 6, 2008 "App. Br."), and the Examiner's Answer (mailed Oct. 1, 2008, "Answer").

“May of appellant’s argument fail from the outset because, . . . they are not based on limitations appearing in the claims” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

The Appellants state: “[t]he Appellants respectfully request that the Honorable Board review the issue raised by the Appellants (i.e. whether or not Haynes identically discloses ‘providing a buyer with access to said aggregated catalog and separate access to at least on of said plurality of supplier catalogs on said commerce site’).” Request 7.

Further, the Appellants argue that “[t]he Honorable Board’s position that Appellants’ arguments are not based on limitation appearing in the claims necessarily requires a claim construction that was not in the record prior to the Decision and is still not within the record after the Decision.” The Appellants assert that Board’s position raises a new ground of rejection and request that Board designates the analysis as such. Request 7-8

DISCUSSION

We have reviewed the Appellant’s Request but do not find that the Appellant has shown the Board to be in error.

The Board did not “refuse” to consider the issue of “whether or not Haynes identically discloses ‘providing a buyer with access to said aggregated catalog and separate access to at least on of said plurality of supplier catalogs on said commerce site’” because this issue was not raised by the Appellant in the Appeal Brief. We could not have misapprehended or overlooked this argument in reaching our Decision because it was not before us.

The entirety of the Appellants’ argument in the Appeal Brief related to the access of the catalogs is reproduced below:

On page 12 of the First Office Action, Appellants also noted that claims 1, 7, 13, and 19 were amended to clarify that a user is able to access a supplier catalog, which is separate from the aggregated catalog. This limitation is neither taught nor suggested by Haynes. On page 3 of the Second Office Action, the Examiner cited a passage in paragraph [0047], which states that “[s]uch an interface permits a buyer to search a catalogue of products and/or services of a particular supplier.” However, absent from this passage and the Examiner’s analysis is an identification of a user being capable of accessing two separate catalogs, one catalog being the aggregated catalog and the second catalog being a supplier catalog.

App. Br. 15 (emphasis original).

This argument does not raise the issue of “whether or not Haynes identically discloses ‘providing a buyer with access to said aggregated catalog and separate access to at least one of said plurality of supplier catalogs on said commerce site.’” (Request 7) but instead raises the issue of whether or not Haynes describes that a user is able to access two separate catalogs. Our response directly addresses the issue actually raised by the Appellants; that is that Haynes does not disclose that a user is able to access a supplier catalog, which is separate from the aggregated catalog. *See* Decision 9. We found the Appellants’ argument was based on a limitation not required by the claim. *Id.*

Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue – or, more broadly, on a particular rejection – the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. . . Thus, the

Board will generally not reach the merits of any issues not contested by an appellant.

In re Frye, 94 USPQ2d 1072, 1075 2009-006013 (BPAI 2010)(precedential).

Furthermore, in as much as the Appellant is now asking the Board to review whether or not Haynes describes the limitation actually recited in claim 1 - “providing a buyer with access to said aggregated catalog and separate access to at least one of said plurality of supplier catalog on said commerce site” - (Request 7), the Appellant provides no arguments addressing the Examiner’s finding that paragraphs 17-18 and 47 of Haynes describe this limitation (*see Answer 4*). “It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art.” *In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991). See also *In re Wiseman*, 596 F.2d 1019, 1022 (CCPA 1979) (arguments must first be presented to the board). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim 37 C.F.R. § 41.37(c)(1)(vii).

As to the Appellants’ request that the Board designate its rationale, reproduced above, as a new grounds of rejection because the Board’s reasoning necessarily requires a claim construction that the Appellant did not have the opportunity to respond to (*see Request 7-8*), the criterion of whether a rejection is considered “new” in a decision by the Board is whether Appellant has had a fair opportunity to react to the thrust of the rejection. *In re Kronig*, 539 F.2d, 1300, 1303 (CCPA 1976). The Board’s reasoning that the Appellant responded to the Examiner’s rejection by

arguing a limitation not found in the claim, does not change the Examiner's rationale in rejecting the limitation actually recited by the claim. The Examiner's rejection addresses the step of providing a buyer with separate access as it is actually recited (*see* Answer 4). The Appellant was given a fair opportunity to respond to the Examiner's rejection of the actually recited limitation, but instead chose to present an argument direct to a limitation not recited. Since the Appellant has had a fair opportunity to respond to the Examiner's rejection, we decline to designate our affirmance as a new ground of rejection under 37 C.F.R. § 41.50(b).

CONCLUSION

We have carefully considered the arguments that the Appellants have set forth in the Request but, for the foregoing reasons, we do not find them persuasive as to error in the Board's decision of September 23, 2010 affirming the decision of the Examiner to reject claims 1, 4-7, 10-13, and 16-20 and reversing the Examiner's decision to reject claims 2, 3, 8, 9, 14, and 15.

DENIED

mev

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